

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

THOMAS A. SIMONIAN,	)	Case No.: 10-CV-05544-LHK
	)	
Plaintiff,	)	
	)	ORDER GRANTING PLAINTIFF
v.	)	LEAVE TO FILE SECOND AMENDED
	)	COMPLAINT
MONSTER CABLE PRODUCTS, INC.,	)	
	)	
Defendant.	)	

---

## I. INTRODUCTION AND BACKGROUND

On February 24, 2010, Thomas A. Simonian (Plaintiff) filed a complaint alleging false patent marking against Monster Cable Products, Inc. (Defendant) in the Northern District of Illinois. On March 5, 2010, Plaintiff filed a First Amended Complaint (FAC). On November 22, 2010, Judge Bucklo granted Defendant's motion to transfer the case to this District. Accordingly, the case was transferred to the Northern District of California on December 7, 2010. On March 14, 2011, Defendant filed a motion to dismiss Plaintiff Thomas Simonian's First Amended Complaint ("FAC") for False Patent Marking. On March 15, 2011, after Defendant filed its motion, the Federal Circuit issued a decision clarifying the pleading standard applicable to false marking claims under 35 U.S.C. § 292. *In re BP Lubricants USA Inc.*, --- F.3d ----, 2011 WL 873147, Misc. No. 960 (Fed. Cir. Mar. 15, 2011). Pursuant to the Federal Circuit's decision, "Rule 9(b)'s particularity requirement applies to false marking claims and . . . a complaint alleging false marking is insufficient when it only asserts conclusory allegations that a defendant is a 'sophisticated company' and 'knew or should have known' that the patent expired." *Id.* at \*1.

Plaintiff filed both an opposition to Defendant's motion to dismiss as well as a motion for leave to file a Second Amended Complaint ("Motion," "SAC") in light of *BP Lubricants*. See Dkt. Nos. 73, 74. In the Motion, Plaintiff appeared to concede that the FAC was deficient in light of the *BP Lubricants* standard. Accordingly, the Court deemed the FAC dismissed and found Defendant's motion to dismiss the FAC moot. The Court has considered the briefing submitted by the parties relating to the Motion, and finds this matter suitable for decision without oral argument. See Civ. L. R. 7-1(b). Accordingly, the hearing and further case management conference set for June 16, 2011 at 1:30 p.m. are hereby VACATED. The case schedule in the Court's March 2, 2011 Case Management Order remains as set. In addition, a further Case Management Conference is set for September 21, 2011 at 2 p.m. For the reasons set forth below, the Court GRANTS Plaintiff leave to file the SAC.

## II. LEGAL STANDARD

Pursuant to Federal Rule of Civil Procedure 15(a), a party may amend its pleading once as a matter of course within 21 days of serving it. Fed. R. Civ. Pro. 15(a)(1). After that initial period has passed, amendment is permitted only with the opposing party's written consent or leave of the court. *Id.* 15(a)(2). Rule 15 instructs that "[t]he court should freely give leave when justice so requires." *Id.* Although this rule "should be interpreted with extreme liberality, leave to amend is not to be granted automatically." *Jackson v. Bank of Hawaii*, 902 F.2d 1385, 1387 (9th Cir. 1990) (internal citation and quotation marks omitted). Courts commonly consider four factors when determining whether to grant leave to amend: (1) bad faith on the part of the movant; (2) undue delay; (3) prejudice to the opposing party; and (4) futility of the proposed amendment. *Foman v. Davis*, 371 U.S. 178, 182 (1962); *Lockheed Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 986 (9th Cir. 1999). Of these factors, prejudice to the opposing party is the most important. *Jackson*, 902 F.2d at 1387.

## III. APPLICATION

Defendant does not oppose Plaintiff's amendment of his complaint on any of the grounds mentioned above (bad faith, undue delay, prejudice, or futility). Instead, Defendant argues that Plaintiff's complaint should be additionally amended to add a reference to one of its patents, U.S.

Patent D549,174S (the '174 Patent). Defendant argues that this patent "either covers or would reasonably seem to cover" several of the products Plaintiff alleges were mismarked. Opp'n to Mot. at 3-4. Defendant asserts this argument because "the existence of this patent is germane to pleading plausibly that Defendant had specific intent to deceive the public." *Id.* at 4.

Essentially, Defendant asks the Court to order Plaintiff to include a reference to the '174 Patent because it is relevant to one of Defendant's claimed defenses. Defendant cites no authority for this position, and the Court is unaware of any authority that would support such an order. Generally, of course, "the plaintiff is the master of the complaint . . . ." *Lincoln Prop. Co. v. Roche*, 546 U.S. 81, 91 (U.S. 2005). If Defendant wishes to reference its '174 Patent in connection with a motion to dismiss the SAC, it may certainly do so. While the Court declines to take judicial notice of this patent now (as there is no reason to do so), it will entertain a request for judicial notice in connection with Defendant's motion to dismiss. As Defendant points out, the Court may take judicial notice of facts that are "capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." Fed. R. Evid. 201(b)(2). Because the '174 Patent is a U.S. Patent, its contents can readily be determined. If it is appropriate to do so, the Court will take notice of the '174 Patent in connection with Defendant's motion to dismiss.

#### IV. CONCLUSION

Other than Defendant's unsupported request to add reference to the '174 Patent to the SAC, Defendant does not oppose Plaintiff's motion for leave to amend the complaint. Accordingly, Plaintiff's motion is hereby GRANTED. Plaintiff shall file the SAC within 2 days of the date of this Order.

**IT IS SO ORDERED.**

Dated: June 8, 2011

  
LUCY H. KOH  
United States District Judge